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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,857	02/05/2002	Mats Allers	1774/0K258	2347

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EXAMINER

GRAY, PHILLIP A

ART UNIT	PAPER NUMBER
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3767

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/072,857	Applicant(s) ALLERS ET AL.	
	Examiner Phillip Gray	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
4a) Of the above claim(s) 11-34, 45-68 and 72-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 35-44 and 69-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is in response to applicant's communication of 1/25/2006.

Applicant's remarks/arguments draws attention to several inconsistencies in the prosecution, particularly related to the original Restriction and Election Requirements of 10/01/2004 and a second Restriction and Election Requirement of 3/24/2005.

The examiner issued the original Restriction and Election Requirements of 10/01/2004 asking for a restriction and election between claims 1-34 (the method of use) and 35-68 (the apparatus), and did not address, object, or make reference to amended claims 69-76. Further there was a species election that will be discussed below. In the original Election Response of 1/3/2005, applicant chose to elect claims 1-34 directed to a method of use. Examiner draws attention to the fact that claim 34 is drawn to an apparatus and not a method (1-33 was the method of use claim set). Therefore, still technically pending at that time, claim 34 was drawn to the nonelected apparatus set. Further Applicant did not address, object, or make reference to amended claims 69-76 and the fact that examiner failed to prosecute them. Concerning the species election, original Election Response of 1/3/2005 asked applicant to elect one species between species A through F. Applicant in original Election Response of 1/3/2005 chose species C drawn to figure 6a. Applicant stated that claims 1-20, 28,30-32 were generic and did not state any claim directed to the elected species C. Applicant stated claims 21-27, 29, 33 should be examined but failed to state a compelling reason why. Applicant was silent as to claim 34 directed to an apparatus.

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Therefore at that time claims directed to the "method of use" and "Species C" were elected and pending for prosecution. These pending claims would be claims 1-20, 28, and 30-32. All other claims 21-27, 29, 33-68, would not be pending and withdrawn because they were drawn to a non-elected species (claims 21-27, 29, 33) or a restricted apparatus (claims 34-68).

The examiner issued the second Restriction and Election Requirement of 3/24/2005 asking for an election between species contained in elected "method of use" invention (claims 1-34) in the Applicant's application. Examiner in second Restriction and Election Requirement of 3/24/2005 asked Applicant to choose one species in group A with species A-F and on species in group B species AA-VV. It is Examiners understanding that only claims 1-34 were entitled to election of species in the second Restriction and Election Requirement of 3/24/2005, from these two groups, not entire set of claims from 1-68, hence the examiners withdrawing of claims 11-68 in Nonfinal Office Action of 8/25/2005 (claims 35-44 were withdrawn as drawn to a restricted apparatus). Applicant elected from Group A Species F, and from Group B Species AA. Applicant stated they elected claims 1-10 and 35-44. Applicant did not address, object, or make reference to amended claims 69-76 and the fact that examiner failed to prosecute them or make reference to them.

Applicant, in response to office action communication on 1/25/2006, contented that they were entitled to examination of claims 1-10, 35-44 and 69-71 and elected specie that was drawn to those claims.

Due to inconsistencies in the two Restriction and Election actions and the corresponding two applicants elections, Examiner obliges Applicant and will prosecute claims 1-10 (method of use of Species F/AA), 35-44 (apparatus of Species F/AA), and claims 69-71 (methods and apparatus of what applicants consider Species F/AA). Claims 72-76 will be considered claims drawn to a non-elected species and will not be examined and withdrawn.

Election/Restrictions

Claims 11-34, 45-68, 72-76 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/3/2005 and remarks of 1/25/2006. All claims were drawn to a nonelected species and withdrawn as per discussion above.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Amended Claims 1-10, 35-44 and 69-71 are currently pending for examination, as per discussion above. This Non-Final Office Action addresses all claims currently pending in their amended state as 1/25/2006.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the container with gas having brain protective properties, and equipment for inhaling a controlled fraction of gas, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 9 and 43 are objected to because of the following informalities: both claims state a method and an apparatus with a container that is in a range of 37 degrees Celsius. It is unclear and non-descript what is meant by a "range" of "37 degrees Celsius". Is the range "37 degrees" in scope or is it at a temperature of "37 degrees Celsius"? Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2-10, 35, 38-44, 70 rejected under 35 U.S.C. 102(b) as being anticipated by Dobak III et al. (U.S. Patent Number 2001/0011184 A1). Dobak teaches a method for brain hypothermia, said method comprising, in a first phase to enable an early and fast onset of hypothermia, the steps of: providing a container with an infusion solution having a first temperature and a venous infusion catheter connected to an outlet of said container, said venous infusion catheter having an infusion solution lumen; percutaneously inserting an infusion catheter into a peripheral vein; cooling the infusion solution to a second temperature lower than said first temperature; and infusing a cooled infusion solution into said vein via the infusion solution lumen after cooling, to enable the cooled infusion solution to cool the blood while avoiding formation of air bubbles when supplied to said vein.

Claims 1-10, 35-44 and 69-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Magers (U.S. Patent Number 6,830,581) and Magers et al. (U.S. Patent Publication Number 2003/0088299 A1). Magers teaches a method for brain hypothermia, said method comprising, in a first phase to enable an early and fast onset of hypothermia, the steps of: providing a container with an infusion solution having a first temperature and a venous infusion catheter connected to an outlet of said container, said venous infusion catheter having an infusion solution lumen;

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percutaneously inserting an infusion catheter into a peripheral vein; cooling the infusion solution to a second temperature lower than said first temperature; and infusing a cooled infusion solution into said vein via the infusion solution lumen after cooling, to enable the cooled infusion solution to cool the blood while avoiding formation of air bubbles when supplied to said vein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 2-3, 36-37, 69 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobak. Dobak discloses the claimed invention and method except for ranges between 0-10, 0-4, and 0-37 degrees Celsius. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus and method with ranges between 0-10, 0-4, and 0-37 degrees Celsius, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (CCPA 1955).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571) 272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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KEVIN SIRMONS
PRIMARY EXAMINER

Kevin C. Sirmons
5/9/06